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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,610	03/29/2004	Clive Clayton	8009-24	2715
22150	7590	11/30/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			BAREFORD, KATHERINE A	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/811,610

Applicant(s)

CLAYTON ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-9 and 16-18.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Continuation of 5. Applicant's reply has overcome the following rejection(s): the 35 USC 112 rejection of claims 16-18 (paragraph 5 of Final Rejection) only. Claims 16-18 remain rejected under 35 USC 103(a) as discussed in paragraph 12 of the Final Rejection (see discussion in box 11 below).

Continuation of 11. does NOT place the application in condition for allowance because: as to the rejection of claims 1-3 and 6-8 under 35 USC 103(a) using Mahoney in view of Yen, the Examiner has reviewed applicant's arguments at pages 6-7 of the amendment, however, the rejection is maintained. The Examiner has not used impermissible hindsight, but rather has used two references to demonstrate the obviousness of the claimed invention. While Mahoney does not explicitly teach the mixing of a thermal spray coating and substrate (without the second workpiece), this does not prevent the combination of Mahoney with Yen. As discussed in MPEP 2143.01, motivation can be found in the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Also note, "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem as a whole would have suggested to those of ordinary skill in the art." *In re Kotzah* 217 F.3d 1365, 1370, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2002). Here, the Examiner has cited Yen as showing that it is well known to provide a substrate with a thermal spray coating and then to mix together the coating and substrate to form a composite material at the surface of the substrate that consists of the thermal spray coating material and the substrate. While, Mahoney does not teach this feature and Yen does not teach friction stir welding, the combined teachings and the knowledge of one of ordinary skill in the art would suggest the combination of the references for the reasons given in paragraph 11 of the Final Rejection. It is not necessary that the individual references explicitly teach all the features of the claims or specifically suggest combining with another reference as discussed in MPEP 2143.01 and the citations above. As to the rejection of claims 2, 3, 6-8; 4-5; and claim 9 under 35 USC 103(a), the Examiner has reviewed applicant's arguments at pages 8-9 of the amendment, however, the rejection is maintained. As the rejection of parent claims 1-3 and 6-8 is maintained for the reasons discussed above, the rejection of these claims is maintained. As to the rejection of claims 16-18 under 35 USC 103(a), the Examiner has reviewed applicant's arguments at pages 9-10 of the amendment, however, the rejection is maintained. For the same reasons as the rejection of claims 1-3 and 6-8 is maintained as discussed above, the use of Mahoney and Yen in combination is maintained. As to the further use of Salito, the Examiner notes that Salito indicates that it is preferred to apply the second layer immediately after the first. However, this is merely a preferred embodiment, and it is not required to do so. As discussed in MPEP 2123, preferred embodiments do not constitute a teaching away from a broader disclosure.

  
KATHERINE BAREFORD  
PRIMARY EXAMINER